

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s): Jussi Kuisma CONF. NO.: 5685
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TITLE: ARRANGEMENT FOR IMPLEMENTING TRANSMISSION OF MULTIMEDIA MESSAGES
ATTORNEY
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REPLY BRIEF

This is in response to the Examiner's Answer mailed on December 11, 2006.

It is respectfully submitted that the Examiner has confused the concepts of multimedia and email.

Claim 1 of the instant application reads:

A method of transferring a multimedia message in a multimedia messaging system, which comprises a terminal and a multimedia messaging centre, which are arranged to

communicate with each other at least partially wirelessly, the multimedia messaging centre being arranged to receive multimedia messages addressed to the terminal and transmit a notification message to the terminal to inform it of a multimedia message addressed to the terminal which has arrived at the multimedia messaging centre, wherein the method comprises:

transmitting a first message wirelessly from the terminal to the multimedia messaging centre, the first message requesting the multimedia messaging centre to transmit a notification message to the terminal on multimedia messages addressed to the terminal which have arrived at the multimedia messaging centre and on which the terminal has not received a notification message yet, wherein said first message comprises an option to define a selection criterion so as to limit information to be sent in response to said first message.

The Examiner's arguments are directed towards the conventional email system, while Applicant's claims are directed to multimedia messaging systems. For example, on page 11, the Examiner refers to Zahariev, Col. 3, line 64 to Col. 4, line 1. However, this section of Zahariev relates to information based on "email", and not multimedia messages.

Advanced mobile phones having a multimedia messaging function can, and those who operate these devices know that these devices can, send a multimedia message to **either** another terminal **or** to an email address. This functionality is defined in the third generation mobile communication networks specification 3GPP TS 23.140 (the "3GPP") which is referenced by the Examiner. See for example page 11 section 5.1 which reads: "MMS shall support the use of either E-Mail addresses (RFC 822) or MSISDN. In the case of E-Mail addresses standard internet message routing could be used." The MSISDN (Mobile Station International ISDN Number) is the standard international telephone number, i.e., the telephone number associated with the user's terminal.

The claimed invention is directed to solutions in which “multimedia messages” are addressed to terminals, as recited in claim 1. Contrary to what the Examiner alleges, the claims do not recite features to conventional email and do not cover the part of the multimedia messaging service in which multimedia messages are sent to email addresses.

The “multimedia messages” as recited in the claims do not include email messages, because emails are not addressed to a terminal, but are rather addressed to user email addresses. In other words, email messages are not destined to the address (e.g., a phone number, MSISDN, or similar) of a terminal as recited in the claims. Rather, email messages are addressed to an email address (e.g., firstname.lastname@domain.xyz). Addressing a message to a terminal (such as addressing a multimedia message to a phone number) is not to be confused with email. The destination address of a regular email is not the same as a terminal address.

Furthermore, claim 1 recites a multimedia messaging system. This expression does not include conventional email. The term “multimedia messaging system” will be clearly understood by one of skill in the art to be something other than a conventional “email” message. As demonstrated earlier, with for example the Webobedia™ reference, the “multimedia messaging system” is not the same as the email system.

The Examiner states that the specification does not adequately define the term “multimedia messages.” Applicant respectfully submits that the specification does indeed provide adequate description of the term and its intended meaning.

The Background of the Invention on page 1 of the specification opens with the “*multimedia messaging service is a communication service under development in which a terminal of a cellular network can send multimedia messages to another terminal.*”

The above passage, furthermore, defines that in *multimedia messaging service ... a terminal of a cellular network can send multimedia messages to another terminal*. This is yet another indication indicating what type of service the multimedia messaging service is meant to be, and again excludes the email systems, since in email systems, messages are not sent between terminals but between email addresses.

Page 1 of the specification states that the "*transmission service of multimedia messages in connection with the WAP system (Wireless Application Protocol) is defined in the standard specifications WAP-206-MmsMessagingService and WAP-209-MMSEncapsulation. In the third-generation mobile communication networks the multimedia messaging service is to be implemented in a similar manner.*"

This passage, and the ones above, present a clear indication that the "multimedia messages" claimed by Applicant are not the same as, and are something other than, the conventional email that is suggested by the Examiner. It is respectfully submitted that the allegations of the Examiner in the Response to Argument, and particularly pages 13-16, that the term "multimedia messaging" is not described in the specification and therefore can be interpreted to also include email, is erroneous and totally without basis.

Thus, it is respectfully submitted that the description and the claims properly limit the term "multimedia messaging" to exclude regular emails.

Additionally, it is submitted that the claimed "defined query" is not properly held to be the "functional equivalent" of selectively filtering information. On page 11 of the Examiner's Answer it is stated that:

'In response to the above argument, the examiner points out that 3GPP was not relied upon for the rejection of this limitation. The defined query is taught in Zahariev on line

64 of column 3 through line 1 of column 4 which disclose: 'The here-presented system provides an ability to selectively filter information based on e-mail, and to notify a subscriber of availability of such selected information, giving the subscriber an option to have the message forwarded either by e-mail or fax to a specific location.' Hence the claimed defined query has been interpreted as being a functional equivalent to the teaching of selectively filtering information."

It is respectfully submitted that this analysis is erroneous. First, Zahariev relates to "e-mail" and not "multimedia messages" as recited by Applicant in the claims. Secondly, a functional equivalent would require that the claimed limitation and Zahariev "perform substantially the same function in substantially the same way to achieve substantially the same result". This is not the case here.

Claim 1 recites that "*said first message comprises an option to define a selection criterion so as to limit information to be sent in response to said first message*". Zahariev does not teach the claimed first message or a corresponding message and an option to define a selection criterion in that message.

A result achieved by this feature is that instead of sending notifications on all messages addressed to the terminal, only a limited set can be sent to the terminal. Zahariev does not achieve the same result nor does it use the same ways in achieving its result.

First of all, unlike in the claimed invention, Zahariev does not disclose any notifications that would be notifications on messages addressed to a terminal. Instead, Zahariev only discloses notifications on messages addressed to an email address.

Second, Zahariev does not send notifications to the same terminal to which the multimedia terminal is addressed (it should be noted that this feature is recited in the claims). To the contrary, in Zahariev the email is first delivered to the email address to

which it was addressed. Only after that occurs is a notification sent to a terminal. However, the terminal to which the notification is sent does not have much to do with the address to which the email message was delivered. In Zahariev, a notification is sent about a message which was already delivered to the addressee, and even so the notification is not sent to the addressee but to another destination.

In Zahariev, no notification is requested by means of a "first message". First, an email is delivered to the addressee and correctly received by the addressee. A copy is kept in the email server. The "email" is then analysed by the server based on a pre-configured criteria. If the "email" message matches the criteria, an alert (notification) is sent to a pager. The alert may contain an ID with the aid of which the user of the pager can call an operator or call into a voice-response system, identify and request the email, which was already received in his/her normal email address, to be sent to another address/device. In other words, all Zahariev does is manipulate messages which have already been received by the addressee.

On page 17 the Examiner alleges that Col. 3, line 64 through Col. 4, line 14 of Zahariev would teach a selection criterion which would limit information to be sent in response to the first message. However, claim 1 further requires that the selection criterion be such that it would limit information to be sent in response to the first message. This section of Zahariev does not disclose or suggest this feature claimed by Applicant since there is no teaching of a first message. Furthermore relating to allegations on page 17 through page 18, there is no need to send any notification to the addressee in Zahariev's solution, since the email message has already been received by the addressee.

Since Zahariev does not present the first message as is recited in Applicant's claims, Zahariev cannot present an option to define a selection criterion in a non-existing first message. Thus, this feature claimed by Applicant is not disclosed or suggested by Zahariev.

Motivation to Combine

The Examiner states the cited references are from the same field of endeavour. Applicant respectfully disagrees. The present application is concerned with failures of sending notifications in a multimedia messaging system, while 3GPP is concerned with a general framework of a multimedia messaging system. Zahariev is only concerned with getting an email message, which has already been properly received by its addressee, to be transmitted to another destination than originally intended.

There is absolutely no link between the problem environment of Applicant's claimed invention and Zahariev. 3GPP already mentions that a multimedia message can be sent to an email address, but does not present any specific problem relating to email. Therefore, there is no need for a skilled person to look to anything in email world. Concerning pages 20 and 21 where the Examiner talks about the field of endeavour, it should be noted that Applicant's claims are directed to getting a message delivered to the addressee. In Zahariev, the purpose is to forward a message, which has already been received, to other destinations. These are not the same, the features cannot be disclosed or suggested, and the requirements need to establish a motivation to combine under 35 U.S.C. §103(a) cannot be satisfied.

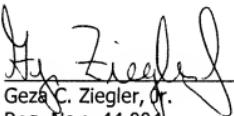
Also, e-mail and 3GPP are not related as suggested by the Examiner. On page 1 of the specification, it is noted that before delivering a message, a notification is sent. After that the problem of missing notifications is discussed. Zahariev does not concern this problem at all, since in Zahariev the email message is delivered and properly received by the addressee without sending a notification first. Therefore, there is no need to ask for any notifications, unlike what is claimed by Applicant.

Thus, it is submitted that there is no disclosure or suggestion to combine references in a manner that satisfies a *prima facie* case of obviousness for purposes of 35 U.S.C.

§103(a). (See e.g. MPEP §2144 et seq.) The examiner's reasoning is merely based on improper *hindsight* of Applicant's claimed invention.

The Commissioner is hereby authorized to charge payment for any additional fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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